

PATENT APPLICATION
Attorney Docket No. 15966-539 (CURA-39)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Rothberg *et al.*
SERIAL No.: 09/417,386 EXAMINER: J. Taylor
FILING DATE: October 13, 1999 ART UNIT: 1656
FOR: METHOD OF IDENTIFYING NUCLEIC ACIDS

August 9, 2000
Boston, Massachusetts

Assistant Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence, and any documents referred to as attached hereto, is/are being transmitted to the United States Patent and Trademark Office, Facsimile Number: (703) 308-8724 on this 9th day of August, 2000.

David Johnson

Attached hereto for filing in the present application are the following documents:

☒ Response to Restriction Requirement mailed July 17, 2000 (2 pages).

The Commissioner is authorized to credit any overpayment or charge any deficiencies to Deposit Account No. 50-0311, Reference No. 15966-539 (CURA-39). A duplicate copy of this Transmittal Letter is enclosed.

If the enclosed papers are considered incomplete, the Mail Room is respectfully requested to contact the undersigned collect at (617) 542-6000, Boston, Massachusetts.

Date: August 9, 2000

Respectfully submitted,

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Official
J

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PRELIMINARY AMENDMENT AND RESPONSE TO RESTRICTION REQUIREMENT
DATED JULY 17, 2000

Prior to examination of the application and in response to the Restriction Requirement mailed July 17, 2000, please amend the application as follows and consider the following remarks.

In the claims:

In claim 9, line 2, add after "cDNA molecules" --, thereby producing ligation products."

In claim 11, line 1, replace "8" with --10--.

REMARKS

Claims 9 and 11 have been amended to address various informalities and to more particularly point out the claimed invention. No new matter has been added

In response to the Restriction Requirement mailed July 17, 2000, Applicants elect with traverse the invention of Group I, claims 1-20, drawn to a method of screening a population of nucleic acids for a novel sequence, classified in class 435, subclass 6.

Applicants respectfully traverse the restriction requirement for the following reasons.

The Manual of Patent Examining Procedure ("MPEP") states at section 803 that for a requirement for restriction to be proper, there must be a serious burden on the examiner if restriction is required.

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In the instant restriction requirement, the subject matter of Group I includes two independent claims, claim 1 and claim 20. As is explained below, a search of the subject matter of the claims placed in Group I encompasses the subject matter of Group II.

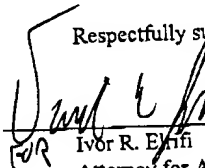
Claim 1 is drawn to a method of screening a population of nucleic acids. Various claims depending from claim 1 require separation, cloning and amplification of the partitioned nucleic acids (*see, e.g.* claims 9, 10, and 17). Additional claims depending from claim 1 specify that the population of nucleic acids is a population of RNA molecules derived from the 5' ends of RNA molecules (*see, e.g.*, claims 2-4). Thus, the subject matter of claim 1 encompasses a method of producing a population of nucleic acid molecules enriched for 5' regions of mRNA molecules, and a method of identifying an RNA sequence in a population of RNA molecules.

Applicants note that this subject matter is also the subject matter of Group II, which includes claims 21-26. Accordingly, no serious burden is placed on the Examiner by searching together the subject matter of the claims of Groups I and Group II. Applicants therefore request reconsideration of the Restriction Requirement.

The Commissioner is hereby authorized to charge payment of any filing fees required in connection with the papers transmitted herewith, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 15966-539 (CURA-39).

Date: August 9, 2000

Respectfully submitted,


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